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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,254	08/31/2001	Rachel Meyers	MNI-188	1955

959 7590 07/02/2002

LAHIVE & COCKFIELD
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EXAMINER
RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 07/02/2002 7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/945,254	MEYERS ET AL.	
	Examiner	Art Unit	
	Manjunath N Rao	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-31* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12 and 22, drawn to polynucleotides, vectors, host cells and a method of making the polypeptide, classified in class 435, subclass 69.1.

II. Claims 13-15, drawn to polypeptides, classified in class 435, subclass 193.

III. Claim 16 and 19, drawn to an antibody, classified in class 530, subclass 387.1.

IV. Claim 17-18, drawn to a method of detecting the presence of the polypeptide using the antibody, classified in class 435, subclass 7.4.

V. Claims 20-21, drawn to a method of detecting the polynucleotides, classified in class 435, subclass 6.

VI. Claims 23-24, drawn to a method of identifying a compound which binds to a polypeptide, classified in class 435, subclass 15.

VII. Claim 25, drawn to a method of modulating the activity of the polypeptide using a compound, classified in class 435, subclass 4.

VIII. Claim 26, drawn to a method of identifying a compound which modulates the activity of the polypeptide, classified in class 435, subclass 4.

IX. Claims 27-28, drawn to a method of identifying a subject having cellular proliferation etc. using nucleotide sequences, classified in class 435, subclass 6.

X. Claim 29, drawn to a method of identifying a subject having cellular proliferation using the polypeptides, classified in class 435, subclass 4.

XI. Claim 30, drawn to a method of identifying a compound capable of treating a cellular proliferation, classified in class 424, subclass 278.1.

XII. Claim 31, drawn to a method of treating a subject having a cellular proliferation using a modulator, classified in class 424, subclass 278.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III are patentably distinct from each other. The polypeptide of group II, the polynucleotide of group I and the antibody of group III, each comprise amino acid sequences and nucleotide sequences which are chemically unrelated, do not require each other for practice; have separate utilities, such as use of the group II polypeptide to catalyze a galactosyltransferase reaction versus the use of polynucleotide in a hybridization reaction and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Inventions IV through XII are patentably distinct from each other. The method of detecting the presence of the polypeptide using the antibody of group IV, the method of detecting the polynucleotides of group V, the method of identifying a compound which binds to a polypeptide of group VI, the method of modulating the activity of the polypeptide using a compound of group VII, the method of identifying a compound which modulates the activity of the polypeptide of group VIII, the method of identifying a subject having cellular proliferation etc. using nucleotide sequences of group IX, the method of identifying a subject having cellular proliferation using polypeptides, of group X, the method of identifying a compound capable of treating a cellular proliferation of group XI, the method of treating a subject having a cellular

proliferation using a modulator, of group XII, are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions I and V, IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides can be used to make recombinant polypeptides as opposed to the use in groups V, IX.

Inventions I and IV, VI-VIII, X-XII are patentably distinct from each other. The product of group I is neither made nor used in the methods of groups IV, VI-VIII, X-XII. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions II and IV, VI, VII, VIII, X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of group II can be used to raise specific antibody as opposed to the uses in groups IV, VI, VII, VIII, X.

Inventions II and V, IX, XI, XII are patentably distinct from each other. The product of group II is neither made nor used in the methods of groups V, IX, XI, XII. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions III and IV, VI, VII, VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody can be used for affinity purification of the polypeptide as opposed to its use in the methods of groups IV, VI, VII, VIII.

Inventions III and V, IX, X, XI, XII are patentably distinct from each other. The product of group III is neither made nor used in the methods of groups V, IX, X, XI, XII. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N Rao whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

Manjunath N. Rao
June 26, 2002